

### **REMARKS/ARGUMENTS**

Reconsideration of this Application and entry of this Amendment after Final are respectfully requested. Claims 1, 4, 6-8, 10, 11, 34 – 37, 39 and 40 are pending, with 1, 36 and 39 being the independent claims. Claims 2, 3, 5, 9, 12-33 and 38 have been canceled without disclaimer of or prejudice to the subject matter thereof. Claims 1, 34-36 and 39 are sought to be amended. These changes do not introduce any new matter.

The proposed amendment places the claims in form for allowance or in better form for appeal. Additionally, this amendment addresses items brought up by the examiner in the final office action. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

#### **Allowable Subject Matter**

Claims 6, 10, 11, 34 and 38-40 are objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form to include all limitations in the base claim and any intervening claims. Applicant has amended independent claim 36 to include the limitation of, now canceled, dependent claim 38 and has rewritten claim 39 in independent form. As such, independent claims 36 and 39 are in condition for allowance, as are claims 37 and 40 that depend respectively therefrom.

Claims 6, 10, 11, and 34 depend from independent claim 1 that is argued below as being patentable over U.S. Patent No. 6,315,757 to Chee *et al.* (“Chee et al.”). As such, these dependent claims have not been rewritten in independent form because Applicant believes they are in condition for allowance. Please note that claim 34 has been amended to address an antecedent basis issue identified by the Applicant upon review of the claims.

#### **35 U.S.C. §112 Rejections**

Claim 35 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it depends from a canceled claim, *i.e.*, claim 12. Claim 35 has been amended to depend from claim 34. As such, Applicant has rendered moot this rejection of the claim. Claim 35 indirectly depends from independent claim 1, which is argued below to be patentable over Chee et al. Therefore as there are no other rejections of claim 35, Applicant avers that claim 35 is now in condition for allowance.

35 U.S.C. §102(b) Rejections

Claims 1, 4, 7 and 36-37 stand rejected under 35 U.S.C. §102(b) as being anticipated by Chee et al. The Examiner states that "Chee et al. discloses a catheter having a proximal shaft having a guidewire (gw) and an inflation lumen and a distal shaft wherein the distal shaft has greater flexibility than the proximal shaft and a transition section having a spiral helix which provides for gradual increase in flexibility in the transition section. The spiral helix is partially free-floating within the inflation lumen. See figure 4." Office Action p. 3.

As discussed above, claim 36 has been amended to include the subject matter of claim 38 and is now in condition for allowance, as is claim 37 that depends therefrom.

Applicant avers that claim 1 is not anticipated by Chee et al. With reference to FIG. 1 of Chee et al. reproduced below, catheter assembly (100) includes balloon (114) at the distal end of the catheter and includes a proximal shaft section (106) and a shaft mid-section (104) that is proximal of a balloon section (102).

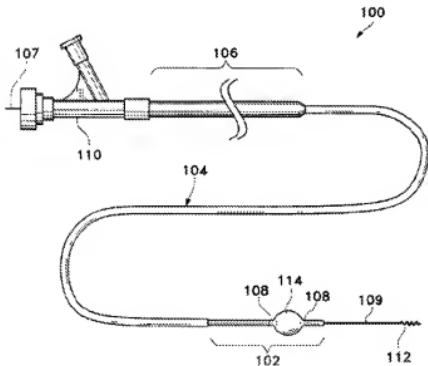


Fig. 1

With reference to FIGS. 2B and 4 of Chee et al. reproduced below, proximal shaft section (106), shaft mid-section (104) and the shaft portion of (102) proximal of balloon (108, 114) is of

the construction shown in FIG. 2B with braid layer/member (204) embedded between outer covering (200) and inner liner (202). See Chee et al. col. 4, lines 33-38 and col. 5, lines 2-46. As such, only within balloon (114) is braid layer/member (204) not embedded in the catheter shaft.

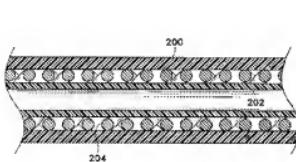


Fig. 2B

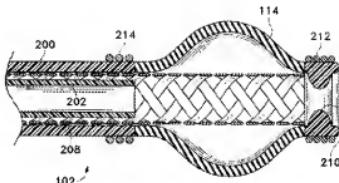


Fig. 4

Claim 1 recites that the spiral helix is at least partially free-floating within an inflation lumen of a transition section that has *a proximal end communicating with the proximal shaft and a distal end communicating with the distal shaft*. As such, the transition section, and specifically the spiral helix, of the embodiment of claim 1 is between the proximal and distal shafts. The portion of the spiral helix of Chee et al in FIG. 4 that the Examiner appears to rely on for teaching this feature of claim 1 is clearly within balloon (114) and not in a transition section between any of the shaft portions (102, 104, 106).<sup>1</sup> Further, claim 1 recites an inflation lumen of the proximal shaft is arcuate shaped and reinforced with a tube having an arcuate shaped cross-section, a feature that is not disclosed or suggested in any of the embodiments of Chee et al. For at least the foregoing reasons, claim 1 is not anticipated by and is patentable over Chee et al.

Claims 4 and 7 depend from and add further features to independent claim 1 and are patentable for that reason alone. While it is not necessary to address the Examiner's rejection of the dependent claims at this time, Applicant reserves the right to support their patentability, when necessary.

<sup>1</sup> Of note, items (210, 212) in FIG. 4 of Chee et al. are a valve seat and marker band, respectively, and not a distal shaft according to claim 1.

35 U.S.C. §103(a) Rejections

Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Chee et al. Claim 8 depends from and adds further features to independent claim 1 and is patentable for that reason alone. While it is not necessary to address the Examiner's rejection of the dependent claim at this time, Applicant reserves the right to support its patentability, when necessary.

**CONCLUSION**

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-0221.

Respectfully submitted,

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